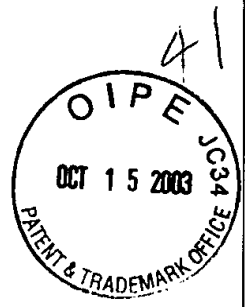


1647



PATENT
Customer No. 22,852
Attorney Docket No. 02481.1732-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:)
Hans-Willi JANSEN et al.)
Application No.: 10/067,457) Group Art Unit: 1647
Filed: February 7, 2002) Examiner: S. L. WEGERT

For: PROCESS FOR IDENTIFYING SUBSTANCES WHICH MODULATE THE
ACTIVITY OF HYPERPOLARIZATION-ACTIVATED CATION CHANNELS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION/ELECTION OF SPECIES REQUIREMENT

Sir:

In a Restriction Requirement dated September 15, 2003, Examiner required restriction under 35 U.S.C. § 121 between the claims of Group I (claims 1-23, 27-55, and 59-64), the claims of Group II (claims 24-32, 51, and 56-58), and the claims of Group III (claim 65). Applicants elect to prosecute Group II, claims 24-32, 51, and 56-58, *with* traverse.

With regard to Groups I and II, Applicants submit that the claims of Group II all depend from the claims of Group I. Thus, in order to search and examine the elected claims, the Examiner must necessarily search and examine the claims of Group I. That is, it is not possible for the Examiner to search and examine a dependent claim without, at the same time, searching

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and examining the claim from which it depends. Accordingly, there can be no additional serious burden on the Examiner to examine the claims of Group I with those of elected Group II. MPEP § 803 states that "if the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits" (emphasis added herein by Applicants). It is respectfully submitted that this policy should apply in the present application with regard to Groups I and II in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Examiner.

In addition to the Restriction Requirement, the Examiner required Applicants to elect a single species from among those listed on page 3 of the Office Action. In response, Applicants elect species "a)" (HCN1) for initial examination in this application. Applicants request that, if the elected species is found allowable, the Examiner continue to examine the full scope of the elected claims to the extent necessary to determine the patentability of the claims. That is, Applicants request that the Examiner extend the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

In view of the above remarks, Applicants respectfully request withdrawal of the Restriction Requirement, at least with respect to Groups I and II. In the event that the Examiner does not withdraw the Restriction Requirement, Applicants reserve the right to prosecute the non-elected claims in divisional or continuation applications. Early and favorable action on the merits is respectfully requested.

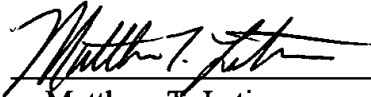
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Please grant any extensions of time required to enter this Response and charge any required fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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Date: October 15, 2003

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